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| 31625 7590 09/11/2007 BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039 | | | EXAMINER DASS, HARISH T | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/834,035 | Applicant(s) PEROT ET AL. | |
| | Examiner Harish T. Dass | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 19-27, 30-39 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) 50-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-27, 30-39, 41-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/5/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims:

Claims 17-18, 28-29, 40 are canceled.

Claims 50-68 are withdrawn.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holmann (hereinafter Fernandez – US 5,787,404) in view of Seto et al (hereinafter Seto – US 6,157,914) and Raphel (Raphel, Murray “supermarketing yesterday, today and tomorrow”, Direct Marketing v 57n3 PP: 8-20 July 1994 – dialog file 15 id 00891925).

Re. Claim 1-2 and 4 Fernandez discloses, an identifier (investment account which inherently has account number and customer associated record) that identifies a customer relative to an ownership position in a company (long term investment and accumulated funds) [col. 4 line lines 45-65],

a transactional component that facilitates an economic transaction [col. 1 lines 5-21; col. 2 lines 23-36 – see a 401(k) account, .. and the like (self directed pension plan); col. 5 line 47 to col. 6 line 3], and economic transaction and economic activity (point-of-sale transactions) [col. 1 lines 54-63].

Fernandez does not explicitly disclose wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity and economic activity with the customer for determining entitlement of ownership of stocks in the company and a transactional relay component, communicatively coupled to the transactional component, that facilitates a response to a server system regarding the transaction, the response including the identifier for the server system to locate additional information on the customer and to associate the activity with the customer.

wherein the client communicates to the server through an interconnected network, and wherein the economic transaction is a transaction taking place through an interconnected network.

However, client/server network architecture, communication protocols (http, tcp/ip, ftp) and Internet communication and their functions are well-known and are widely used for transferring data/files, shopping, online banking, running calculation at universities by students, etc (For example, Internet browser (yahoo webpage) connects to web server (yahoo web server) using the server's identification name (www.yahoo.com) or IP address (for example 192.0.32.67) and in response customer's selection/entry the browser communicates with web server and the server in response

provides content to the browser (ads, news, linked to other sites or web pages, linked to online shopping's, and etc. Other examples would be intranet, LAN, WAN, ATM, etc.) Further, database and database management for banking, credit card companies and financial institutions are will known where customers account and activities are recorded and managed (updated, saved, retrieved, reported, monitored, etc.).

Raphel (Raphel, Murray "supermarketing yesterday, today and tomorrow", Direct Marketing v 57n3 PP: 8-20 July 1994 – dialog file 15 id 00891925) discloses wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity and economic activity with the customer for determining entitlement of ownership of stocks in the company [see all 4 page - particularly page 2] to allow customer to exchange their incentive points for entitlement of ownership of stocks in company. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Fernandez and include economic activity with the customer for determining entitlement of ownership of stocks in the company, as disclosed by Raphel, to encourage valuable customers to shop and deal with a company which allows them to exchange their incentives points to a long term ownership of the company's stock and the company will benefit from customer's loyalty where a valuable customer may spent an average of \$5000 a year.

Further, It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Fernandaz and Raphel to include shopping online using credit card to provide further incentive to

customers to shop online using companies web-site from their homes using computer and earn more points/stocks.

Seto discloses a transactional relay component [Figure 14 # 1 (storage system), col. 1 lines 62-62 (storing); col. 2 lines 3-5 (storage means identified by identification)], communicatively coupled to the transactional component, that facilitates a response to a server system (centralized management system inherits server) regarding the transaction (patient data history), the response including the identifier for the server system to locate additional information on the customer and to associate the activity with the customer (patient or client) [Abstract, figures 3 (computer network connectivity), 4 (hospital or location ID), 6 (system ID), 14 (information storage system, computer, centralized management system) and associated descriptions].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Fernandez and Raphel and include a database management system for customers economic activities, and a transactional relay component, communicatively coupled to the transactional component, that facilitates a response to a server system regarding the transaction, the response including the identifier for the server system to locate additional information on the customer and to associate the activity with the customer, as disclosed by Seto, to provide a database system for manages and stores customer's information (such as: accounts, rebate information, etc), where the system allow updating, retrieving, storing (saving) customer's information locally or remotely. Further, allow customers to monitor

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their incentive points accumulated and balance of shares holding online using company's browser and web-server and time they want.

Re. Claims 3, 5-12, 48-49 are rejected with same rational as claims 1-2 and 4, where all devices and communication networks claimed are prior art and widely used.

Claims 13-16, 19-27, 30-39, 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer in view of Raphel and Martin et al, 1991, "Basic financial Management", 5th Edition, Prentice Hall Inc., ISBN 0-13-060807-6 (hereinafter Martin).

Re. Claim 13, Nieboer discloses a transactional reception component that receives information on an economic transaction relating to an individual [Figure 1 # 1; C4 L5-L10], a transactional processing component, communicatively coupled to the transactional reception component, that determines in what form the individual may participate in ownership of the company [C1 L5-L13; C1 L32-L33; C2 L40-L44; C22 L47-L50], and the risk associated with the first form of ownership being limited to a predetermined amount, the predetermined amount being less than an initial investment of the individual in the first form of ownership [C3 L15-L21; C11 L1-L60; C19 L64-L67], and a data storage medium (inherent in computer), communicatively coupled to the transactional processing component, that stores information on ownership rights in the company relating to the individual (database) [C8 L18 – intended use] and level of

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economic activity (conditional offer and number of items ... relevant activity) [C3 L48-L67; also C1 L5-L41; C2 L18-L22; col. 2 line 55 to col. 3 line 21; C15 L50 to C16 L67].

Nieboer does not explicitly disclose wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity, and the transactional processing component determining that the individual is entitled to convert a first form of ownership in the company to a second form of ownership.

However, Raphael discloses wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity [see all 4 page - particularly page 2]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and include wherein the economic transaction comprises a purchasing or ordering of goods or services from the company, one or more economic transactions representing economic activity, as disclosed by Raphael, to encourage customers to trade with a particular company where they can accumulate more rebates and incentives at one entity as a valuable customer (in oppose to divided between many entities) which allows them to exchange their incentives points/rebates to a long term ownership of the company's stock.

Martin disclose the transactional processing component determining that the individual is entitled to convert a first form of ownership in the company to a second form of ownership (preferred stock or first type ownership and common stock or second type ownership) [see chapter 20 of Martin pages 743-757, specially pages 1 and 747]

to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and Raphel and include determining that the individual is entitled to convert a first form of ownership in the company to a second form of ownership as disclosed by Martin, to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock.

Re. Claims 14-16 and 19, Nieboer, Raphel or Martin explicitly discloses wherein the transactional reception component is an interface to an interconnected network, wherein the transactional reception component is a mass storage device reader, and wherein the transactional reception component is a keyboard, and wherein the data storage medium is a semiconductor memory. However these are inherent in client/server system (e.g. online trading systems).

Re. Claims 20-21, Martin further discloses wherein the first form of ownership is a preferred stock, and wherein the second form of ownership is a common stock [Martin - pages 743-757, specially pages 1 and 747]. to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock.

Re. Claims 22-23, Nieboer *does not explicitly disclose* wherein the predetermined amount is zero, and wherein the predetermined amount is less than 20 percent of the initial investment. However these are business choices depending company's business philosophy, financial structure, incentive structure, etc.

Re. Claims 24-27, claims 24-27 are rejected with same rational as claims 13-16.

Re. Claim 30, claim 30 is rejected with same rational as claim 19.

Re. Claims 31 and 32, claims 31-32 are rejected with same rational as claims 20-21.

Re. Claims 33, 38-39 Nieboer discloses monitoring economic activity associated with the individual [see entire document of Nieboer particularly; Abstract; Figures 1-3, 16; C1 L5-L41; C2 L18-L22; C15 L50 to C16 L67];

and limiting the risk associated with the first type of ownership to an amount less than the investment [C3 L15-L21; C11 L1-L60; C19 L64-L67], and wherein the predefined criteria (constraints) is a level of economic activity [col. 2 line 55 to col. 5 line 10]. Nieboer does not explicitly disclose - wherein the economic transaction comprises an acquisition of goods or services from the company, one or more economic transactions representing economic activity, and economic activity with the customer for determining entitlement of ownership of stocks in the company, and offering an individual an opportunity to convert the individual's first type of ownership in the entity to the second type of ownership interest based upon predefined criteria, wherein the first

ownership interest is preferred stock, and wherein the second ownership interest is common stock.

However, Raphel discloses wherein the economic transaction comprises an acquisition of goods or services from the company, one or more economic transactions representing economic activity, and economic activity with the customer for determining entitlement of ownership of stocks in the company, and offering an individual an opportunity to convert the individual's first type of ownership in the entity to the second type of ownership interest based upon predefined criteria (three full books for shares in company stock) [[see all 4 page - particularly page 2] to allow customer to exchange their incentive points for entitlement of ownership of stocks in company. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and include the above features ("wherein the economic transaction ... predefined criteria") as disclosed by Raphel, to encourage customers to shop and deal with a company which allows its valuable customer to exchange their incentives points for entitlement of ownership of the company's stock.

Martin discloses wherein the first ownership interest is preferred stock, and wherein the second ownership interest is common stock. (preferred stock or first type ownership and common stock or second type ownership) [see chapter 20 of Martin pages 743-757, specially pages 1 and 747] to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock. It

would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure Nieboer and Raphel and include wherein the first ownership interest is preferred stock, and wherein the second ownership interest is common stock, as disclosed by Martin, to allow the individual to convert his/her income type security such as preferred stocks (stable income) to different type of security such as common stocks and benefit from rise in the price of common stock.

Re. Claims 34-37, Nieboer discloses the step of monitoring taking place through an interconnected network [C1 L5-L13; C1 L32-L33; C2 L42] and wherein the economic activity is effectuated by a network appliance (terminal) [C22 L47-L50]. Nieboer does not explicitly disclose monitoring occurring over a web browser, and wherein the economic activity is effectuated by a wireless device. However, web browsers and wireless communication systems are well known, and it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Nieboer, Raphel and Martin to include wireless communication system and web browser to use the capability of these new common mode of communication which provides the user more flexibility to trade remotely.

Re. Claim 41, Martin further discloses wherein the first ownership interest has an expiration time [Page 745] to allow the owner to convert the security before number of years have passed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Nieboer and Raphel

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and include an expiration time for the first ownership interest to allow the owner to change the security per specified time stated in original issue.

Re. Claims 42-47, Nieboer discloses the step of limiting the risk comprising investing a portion a proceeds from the investment into a fixed income investment (bond) [C1 L5-L13; C15 L50 to C18 L50], the step of limiting the risk comprising investing a portion a proceeds from the investment into a bond (treasury to bonds) [C1 L5-L13; C15 L50 to C18 L50], the step of limiting the risk comprising investing a portion of the amount of investment with a guarantor (option trader) [C1 L5-L13; C15 L50 to C18 L50]. Nieboer, Raphel or Martin explicitly discloses the step of limiting the risk comprising securing a financial guarantee from a third party, wherein the amount less than the investment is zero, and wherein the amount less than the investment is less than 20% of the investment amount. However these are will-known features to one skill in the art of trading. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Nieboer, Raphel and Martin and specify the risk level, which is acceptable to investor (trader) in case of losses.

Response to argument

Applicant's arguments filed 6/5/07 have been fully considered but they are but are moot in view of the new ground(s) of rejection.

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In response to applicant's argument that Fernandez-Holmann fails to disclose, teach, or suggest "an identifier that identifies a customer relative to an ownership position in a company; a transactional component that facilitates an economic transaction, wherein the economic transaction comprises a purchasing or ordering of goods or services from the company." Applicant has failed to disclose in specification how a customer is identified "an identifier identifies a customer relative to ownership position" specification does not include any reference to customer's relative position of ownership. With broadest reasonable interpretation, Examiner's interpretation of this limitation is either a customer has long term interest in company or short term investor (see Fernandez col. 4 lines 10-14 – see long term investment or will accumulate long term savings – credit card owner is a company and there are many known companies having cards such as HomeDepot provide incentives). Otherwise the examiner would had a rejection under USC 112 2nd indefiniteness (Examiner encourages applicant to provide explanation and reference to this subject in original specification to avoid future USC 112 rejection). Office action discloses a long term investment (investor's ownership position) and accumulated funds is relative position of the client. Investor either has a long term investment position, or short term investment position. Further, customer's relative position base on what? Original specification is silent in this respect, but still applicant argues the relative ownership, etc. If a company (for example Dominion Virginia Power) has 100,000 customer investors which includes executive officers of the company, board members, employee, outside investors, how does the company identifies the customer except the account number. Suppose a customer M1 with last name "Smith"

with m numbers of shares and customers M2, M3, M4, ... M381 with last name "Smith" also have the same number of shares "M", how the invention identifies them? The specification does not provide any disclosure of ranking top investors relative to holding, bottom investors relative to holdings, or etc.

In response to applicant's argument that secondary reference (Seto et al.) a medical support system (nonanalogous art), see *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In response to applicant's argument that secondary reference (Seto et al.) fails to disclose "a transactional relay component, communicatively coupled to the transactional component, that facilitates a response to a server system regarding the economic transaction, the response including the identifier for the server system to locate additional information on the customer and to associate the economic activity with the customer for determining entitlement of ownership of stocks in the company", and Seto et al. discloses a medical support system. Computer system of Seto et al. information management system can be adopted to store information about customer and their activates similar to information is stored for patients and their medical history (medical activity). Seto et al. centralized information management system uses computerized system, having network interface and network communication (known such as: internet, intranet, etc) (see Seto et al at least Figures 1-3 and associated descriptions; col. 3 lines 15-25) which can be used for storing and retrieving information into/from, where

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the relay component is the network communication (example, telephone lines, internet, etc) and server is inherently used by the centralized information management system of Seto et al. (see for example Figures 14, & 16 reference to network (2), databases, storages, network interface.) Further, Seto's smart card is capable for storing and transferring customer's economical transaction data into/from computer system. Smart cards are well known for storing and transferring information/data when they are coupled to read/writer systems (example, value smart card download value and stores the amount and transfers the value at point of sale.)

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection "The Examiner relies on a combination of three references ..." does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's "Examiner does not provide any teaching, suggestion, or motivation to combine the references to "associate the economic activity with the customer for determining entitlement of ownership of stocks in the company." This limitation is disclosed by Primary reference and it does not need a motivation to combine. In case of claim 33 the motivation has been stated "provide incentives to customer to participate in rebate program and allow the customers to transfer rebates toward retirement program and also retain the customer base" or "to participate in credit

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based funding of an investment account where the consumer will be able to exchange its purchase credit awards to investment vehicle for retirement account", see office action. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In response to applicant's "it is improper for an Examiner to use hindsight", see *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, applicant has pointed out reference to KSR, Examiner points out the following passages from KSR "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art." Examiner at minimum points out to all prior art reference that have been provided to Applicant during the prosecution, which leads the examiner to conclude that is an obvious combination of converting incentive points earn during purchase from one type of incentive to another type of incentives such as; exchange of credit awards to into purchase of mutual funds, see *Kalina* (US 5,970,480) or *Fernandez-Holmann* which is analogous to exchange of points/rebates to stocks or other type of securities. Applicant should consider all provided prior art references (patents and Non-Patents) and analogous art with respect to this remark.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US 6,415 261 (Cybul et al.) discloses a method for managing a frequent shopper program at a site providing both electronic commerce shopping and in-store shopping, establishing a point of sale (POS) system, having a POS loyalty database and a POS purchase history database; establishing a list builder tool having an on-line shopping history database; establishing a query interface enabling communications between the POS system, and a network browser and, determining a shopper's entitlement to a frequent shopper discount by accessing information from the updated POS purchase history database and the updated on-line shopping history database.

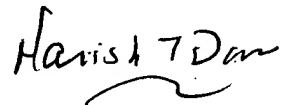
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Harish T Dass
Examiner
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A handwritten signature in black ink that reads "Harish T Dass" with a stylized flourish underneath.

9/1/07